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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,873	10/28/2003	David William Jensen	BAL64US	4100

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393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

KOHNER, MATTHEW J

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,873

Applicant(s)

JENSEN, DAVID WILLIAM

Examiner

Matthew J Kohner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/28/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-8 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,648,321. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of '321 includes the limitation, "providing a fluid flow through a top surface of the stack for effecting separation of the topmost sheet ... from the stack; (emphasis added)"

Claim 1 of the present application includes the limitation of configuring a gas stream, "so that the gas stream penetrates the first sheet [of a stack] to generate a cushion of gas between the first sheet and a second sheet ..." Penetrate is defined as To enter or force a way into; pierce.¹; To pierce or

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enter into something; make a way in or through something.² Hence, in order for the gas stream to penetrate the first sheet, it must "pierce" or "go through" the first sheet. Therefore, it appears that the both sets of claims provide for a device which performs the same function in the same manner. Such a variation from the first device ('321 patent) would be obvious to one of ordinary skill in the art.

Specifically:

Claim 1 (application)

- (a) configuring a gas stream, "so that the gas stream penetrates the first sheet [of a stack] to generate a cushion of gas between the first sheet and a second sheet ..."
- (b) "capturing mechanism for capturing the first sheet"

Claim 1 ('321 patent)

- (a) "providing a fluid flow **through** a top surface of the stack for effecting separation of the topmost sheet ... from the stack; (emphasis added)"
- (b) "pick up device ... that captures ... said topmost sheet"

Claim 2 (application)

- (a) capturing mechanism is displaceable between a pick-up position and a feed position

Claim 1 ('321 patent)

- (a) pick up device that captures said topmost sheet and aids conveyance to said topmost sheet to the printing station.

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In regard to claims 3 and 4, see claim 10 of '321 patent.

In regard to claim 5, see claim 3 of '321 patent, which discloses a plurality of displacement devices.

In regard to claim 6, see claim 9 of '321 patent.

In regard to claim 7, see claim 10 of '321 patent.

In regard to claim 8, see claims 6 of '321 patent.

In regard to claim 12, see claim 2 of '321 patent.

2. Claims 9-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,648,321 in view of US Patent No. 5,876,031 to Ohkoda et al. While the '321 patent does disclose a reciprocating drive mechanism (Col. 3, lines 54+), the '321 patent does not specifically claim it. However, reciprocating drive mechanisms are well known in the art (See e.g. US Patents 5,876,031 to Ohkoda; 6,502,815 to Baureis et al.; 3,130,602 to Nigrelli et al.) and it would be obvious to one of ordinary skill in the art to use a reciprocating drive. Ohkoda discloses a reciprocating drive mechanism with an elongate member and swing arm (See Figs. 5-8).

3. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/693,875. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because while the '875 application is directed toward a printer, it is well known in the art that sheet separation devices, such as claimed in the present application, are used in conjunction with printers (See e.g. US Patent No. 4,887,805 to Hebert et al.). Further, specifically:

In regard to claim 1, see claim 1 of the '875 application.

In regard to claim 2, see claim 1 of the '875 application.

In regard to claim 3, see claim 2 of the '875 application.

In regard to claim 4, see claim 3 of the '875 application.

In regard to claim 5, see claim 4 of the '875 application.

In regard to claim 6, see claim 5 of the '875 application.

In regard to claim 7, see claim 6 of the '875 application.

In regard to claim 8, see claim 7 of the '875 application.

In regard to claim 9, see claim 8 of the '875 application.

In regard to claim 10, see claim 9 of the '875 application.

In regard to claim 11, see claim 10 of the '875 application.

In regard to claim 12, see claim 11 of the '875 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending

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Application No. 10/693,876. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

In regard to claim 1, see claim 1 of the '876 application.

In regard to claim 2, see claim 1 of the '876 application.

In regard to claim 3, see claim 1 of the '876 application.

In regard to claim 4, see claim 1 of the '876 application.

In regard to claim 5, see claim 2 of the '876 application.

In regard to claim 6, see claim 3 of the '876 application.

In regard to claim 7, see claim 4 of the '876 application.

In regard to claim 8, see claim 5 of the '876 application.

In regard to claim 9, see claim 1 of the '876 application.

In regard to claim 10, see claim 6 of the '876 application.

In regard to claim 11, see claim 7 of the '876 application.

In regard to claim 12, see claim 8 of the '876 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

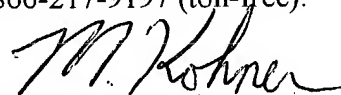
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kohner whose telephone number is 703-305-8496.

The examiner can normally be reached on Mon-Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew J. Kohner
Examiner
Art Unit 3653

mjk



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